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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,315	11/28/2001	Dominick DallaVerde	3546/063	2986

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FISH & NEAVE  
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NEW YORK, NY 10020-1105

EXAMINER

VARGOT, MATHIEU D

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 05/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/996,315

Applicant(s)

DALLAVERDE

Examiner

M. VARGAS

Group Art Unit

1732

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ R sponse to communication(s) filed on 4/11/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) 12-19 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-11 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

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1. Applicant's election with traverse of Group I, claims 1-11 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that the inventions are not properly restricted. This is not found persuasive because in the instant case the product as claimed can be made by another and materially different process such as one in which the watermark is transferred to the disk subsequent to the replication of the information thereon--ie, the watermark can be made in a separate step.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant discloses that the process forms the information portion using the stamper and that during the transfer of the information from the front side of the stamper, the watermark portion is transferred to the disk from the backside of the stamper. However, it is never disclosed as to how this actually occurs. While it may be assumed that the injection pressure allows the watermark to be replicated onto the disk, it is not exactly taught that this is what is occurring. Applicant has failed to describe exactly how the watermark on the rear of the stamper is transferred to the front of the disk during the replication.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent 11-149,673.

Japanese Patent -673 (see the abstract and Figures 4 and 5) discloses the instant process wherein the back side (4b) of a stamper (4) contains marks (a-h) which, during injecting of a resin and replication of the information on the front side (4a) of the stamper, are transferred to the information side of the disk during replication to form an indelible watermark (aa-hh) on the disk. It is submitted inherent that the front side of the stamper contains the information portion which is transferred to the front side of the disk during replication--ie, during the formation of the signal surface 11a on the disk substrate 11.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 11-149,673.

Japanese Patent -673 discloses the basic claimed process lacking essentially the aspects of injection compression molding and sanding the back of the stamper. It is nothing but conventional in the art to perform a compression following an injection of resin when making optical disks and such would have been an obvious addendum to the process of the applied

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reference to facilitate and improve replication of the information. It is also fairly well known to make sure that the back face of a stamper is even and this would have rendered sanding such face as obvious in the process of Japanese -673 to ensure that the stamper makes complete contact with the mold platen 1a, except for of course the watermark portion.

5. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent 11-149,673 in view of Taira et al (see col. 5, lines 4-5).

Japanese -673 discloses the basic claimed process lacking a clear disclosure of how the watermark portion is provided on the back of the stamper. However, Taira et al teaches that laser marking and mechanical means are well known in the art as a way of providing characters or figures on a stamper. Clearly, if one of ordinary skill would use such methods to mark a stamper with a figure, then such would have also been obvious to do so to make the watermark on the back side of a stamper in the process of Japanese -673.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bahns et al discloses making watermarks on optical disks using a laser formed hologram on the stamper.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

April 29, 2003

*M. Vargot*  
MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300  
4/29/03